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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,186

09/29/2003

Rudolph Nobis

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2665

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7590

10/18/2006

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

10/674,186

Applicant(s)

NOBIS ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice of Amendment*

In response to the amendment filed on August 3, 2006, the current rejections of the claims *stand*. The following reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-11, 14-16 and 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0220449 to Zirps et al.

**In regards to claims 10, 16 and 22**, Zirps et al. discloses a medical device comprising: a flexible member 16; an end effector 12 associated with a distal end of the flexible member; and a handle 14 associated with proximal end of the flexible member; wherein the handle comprises an actuator 102 (see Fig. 1a and Paragraphs 37-39).

The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

**In regards to claim 11**, Zirps et al. discloses a medical device wherein the end effector is a biopsy forceps (see Paragraph 0028).

**In regards to claims 14-15**, Zirps et al. discloses a medical device, wherein the actuator comprises a lever (see fig. 1). The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

**In regards to claims 23-26**, Zirps et al. discloses a medical device wherein the release is disposed at a first end of the handle and the actuator is operable and the device comprises a ratchet mechanism (see Fig. 1 and paragraphs 0007-0015). The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0220449 to Zirps et al. in view of U.S. Patent No. 5,624,379 to Ganz et al.

**In regards to claim 12-13**, Zirps et al. discloses a medical device comprising: a flexible member 16; an end effector 12 associated with a distal end of the flexible

member; and a handle 14 associated with proximal end of the flexible member but are silent with respect to wherein the flexible member is at least one meter long. Ganz et al. teach of an analogous endoscopic instrument wherein the flexible member is at least one meter long. Moreover the length of the elongate member may vary according to its intended application. It would have been obvious to one skilled in the art at the time the invention was made to construct a flexible member in the apparatus of Zirps et al. of a length of at least one meter long to provide access to a variety of desired treatment sites deep within body lumen as taught by Ganz et al. and is well-known in the art.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0220449 to Zirps et al. in view of U.S. Patent No. 6,786,865 to Dhindsa.

**In regards to claims 17-20,** Zirps et al. disclose a surgical instrument comprising: a housing adapted for gripping in the palm of a user's hand; and an actuator for actuating an end effector 12 associated with the endoscopic device wherein the actuator is operable by one or more fingers of the same hand, and wherein the actuator is inherently capable of being operable without the use of either of the thumb and index finger of the same hand (see Figs. 1) but are silent with respect to a device for holding the handle to the hand, wherein the device does not require active gripping by any fingers of that hand. Dhindsa teaches of an analogous device wherein an endoscope handle assembly that is releasably secured to a hand of a user of an endoscope. The endoscope valve assembly can be releasably secured to any part of the user's hand (e.g., palm, thumb, or finger) and can be secured either to the hand that holds the

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endoscope or to the user's other hand (see Col. 10, Lines 10-29). Furthermore, Dhindsa teaches that the securing element is capable of being a ring that fits over the user's digit (see Col. 10, Lines 30-59). By securing the valve assembly to the user hand, the user can ensure that the valve assembly can be used with any type of endoscope and can be positioned in a location the user's finds convenient. Additionally, a user may not wish to use some types of securing elements with an endoscope (see Col. 10, Lines 1-9). It would have been obvious to one skilled in the art at the time the invention was made to include a device for securing the handle to the users hand in the apparatus of Zirps et al. in order to provide freedom to the user's other hand to manipulate additional instrumentation as taught by Dhindsa. Furthermore, it would have been obvious to one skilled in the art at the time the invention was made to include a set of directions with the apparatus of Zirps et al. to insure proper usage of the apparatus as it is well-known in the art and considered obvious to include directions to any device.

### ***Response to Arguments***

Applicant's arguments filed August 3, 2006 have been fully considered but they are not persuasive.

Applicant states that the device taught by Zirps et al. is not capable of being "adapted to be operated by the same hand holding the handle while the thumb and index finger of the same hand are free to grip and advance the flexible member". However, as broadly as claimed, Zirps et al. disclose a surgical instrument fully capable for gripping in the palm of a user's hand wherein the actuator is operable without the use of either of the thumb and index finger of the same hand. The words "for" and

"adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. Furthermore, the current claims do not result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

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SUPERVISORY PATENT EXAMINER  
GROUP 3700